

### **REMARKS**

Claims 1, 3-12, 14, 16-27, 29-38, 40, 42-53, 55-64, 66, 68-78 and 101-104 are pending in this application. Claims 1, 3-12, 14, 16-22, 27, 29-38, 40, 42-48, 53, 55-64, 66, and 68-74 are under consideration. Claims 23-26, 49-52, 75-78, and 101-104 are withdrawn. Claims 1, 3, 4-12, 14, 16, 18-22, 27, 29, 30, 31, 33, 34, 36, 40, 42, 44, 45, 47, 48, 53, 55, 56, 57, 59, 60, 62, 66, 68, 70, 71, 73, and 74 are amended herein. Claims 2, 13, 15, 28, 39, 41, 54, 65, and 67 are cancelled herein without prejudice or disclaimer. Support for the amendments to the claims may be found in the claims as originally filed and, in particular, in claims 2 and 13.

This amendment is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding. Further reconsideration is requested based on the foregoing amendment and the following remarks.

#### **Response to Arguments:**

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive. The final Office Action asserts in section 5, at the bottom of page 11, that:

In response to A) The applicant is reminded that the claim limitation must be given their reasonable broadest interpretation.

This is submitted to be incorrect. Under the provisions of M.P.E.P. §2111, the pending claims must be given their broadest *reasonable* interpretation consistent with the *specification* during patent examination, not simply their *broadest* interpretation. As provided therein:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

Since, under the broadest reasonable interpretation of the claims consistent with the specification, IwaZaki is not "executing a confirmation of a validity of the forward destination address," IwaZaki does not anticipate the claimed invention.

Moreover, under the provisions of M.P.E.P. §2111, the broadest reasonable interpretation of the claims must *also* be consistent with the interpretation that those skilled in the *art* would reach, not simply the *broadest* interpretation. As provided therein:

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Since, under the broadest reasonable interpretation of the claims consistent with the interpretation that those skilled in the art would reach, IwaZaki is not "executing a confirmation of a validity of the forward destination address," IwaZaki does not anticipate the claimed invention.

The final Office Action asserts further in section 5, at the bottom of page 11, continuing at the top of page 12, that:

The claim language merely recites executing a confirmation of a validity of the forward destination address. It fails to define or provide any details (i.e. how the confirmation and validation is performed).

Since, as discussed above, IwaZaki is not "executing a confirmation of a validity of the forward destination address," further details as to how the confirmation and validation is performed are submitted to be unnecessary. The specification, in any case, provides the support necessary for the claimed language.

The final Office Action asserts further in section 5, at page 12, that:

IwaZaki teaches verifying if the destination address is registered and upon verification sending result notification (see Column 6, lines 63-Column 7, lines 15, Fig. 7).

This is also submitted to be incorrect. The address book management section 12 of IwaZaki, rather, only registers the transmission *source* address in the address book 13 when the transmission source address is not registered in the address book 13, as discussed more fully below. Even if it were true, however, that IwaZaki is verifying if the destination address is registered, and upon verification sending result notification, that would still not amount to "executing a confirmation of a validity of the forward destination address" as recited in, for example, claim 1. Thus, even under the interpretation of IwaZaki adopted in the final Office Action, IwaZaki does not anticipate the claimed invention.

Finally, the final Office Action asserts in section 5, at page 12, that:

The examiner is broadly interpreting this to be "executing a confirmation of validity of the forward destination address". Therefore, the IwaZaki's teaching of verifying if the destination address is registered and upon verification sending result notification meets the claimed limitation.

Since, under the provisions of M.P.E.P. §2111, the pending claims must be given their broadest *reasonable* interpretation consistent with the *specification*, not simply their *broadest* interpretation, this is also submitted to be incorrect. Reconsideration is thus requested.

**Objections to the Drawings:**

The drawings were objected to for lacking features recited in the claims. The features have been removed from the claims. Fig. 9A has been re-labeled "Fig. 9." Figs. 9B and 9C have been canceled. Support for the amendments to Fig. 9 may be found in Figs. 1 and 9 as filed originally, and in the specification at page 13, lines 6-12 and 19-24, page 14, lines 2-6 and 14-27, continuing at page 15, lines 1, 2, 3, and 8-19. Withdrawal of the objections to the drawings is earnestly solicited.

**Claim Rejections - 35 U.S.C. § 102:**

Claims 1, 3-12, 14, 16-22, 27, 29-38, 40, 42-48, and 53, 55-64, 66, 68-74 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,457,044 to IwaZaki et al. (hereinafter "IwaZaki"). The rejection is traversed to the extent it would apply to the claims as amended. Reconsideration is earnestly solicited.

The second clause of claim 1 recites:

Accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address.

IwaZaki neither teaches, discloses, nor suggests "accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address," as recited in claim 1. IwaZaki, rather, is only checking whether the destination address is registered in the address book. IwaZaki, moreover, generates capability request mail in the B mode and transmits it to the destination, when the destination address is not registered in the address book.

The address book of IwaZaki, however, only includes communication condition information and an electric mail address, but does not include the feature of "a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt

address and the E-mail being to be forwarded to the forward destination address," as recited in claim 1.

In IwaZaki, moreover, communication condition information representing communication *conditions* for image transmission to electronic-mail addresses can be registered in the address book 13 in correspondence with the respective electronic-mail addresses. In particular, as described at column 5, lines 41-45:

As shown in FIG. 2, communication condition information representing communication conditions for image transmission to electronic-mail addresses can be registered in the address book 13 in correspondence with the respective electronic-mail addresses.

Since, in IwaZaki, communication condition information representing communication conditions for image transmission to electronic-mail addresses can be registered in the address book 13 in correspondence with the respective electronic-mail addresses, IwaZaki is not "accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address," as recited in claim 1.

The address book management section 12 of IwaZaki, moreover, executes transmission *source* address registration processing when electronic-mail is received. In particular, as described at column 5, lines 59, 60 and 61:

When electronic mail is received, the address book management section 12 executes transmission source address registration processing as shown in FIG. 3.

Since, in IwaZaki, the address book management section 12 executes transmission source address registration processing when electronic-mail is received, IwaZaki is not "accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address," as recited in claim 1.

The third clause of claim 1 recites:

Executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded, by sending a test mail to the forward destination address and receiving a response to the test mail.

IwaZaki neither teaches, discloses, nor suggests "executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded,

by sending a test mail to the forward destination address and receiving a response to the test mail,” as recited in claim 1. The confirmation includes confirming whether the response contains a predetermined data string are not. The address book management section 12 of IwaZaki, on the other hand, only registers the transmission *source* address in the address book 13 when the transmission source address is not registered in the address book 13. In particular, as described at column 6, lines 13-17:

Only when the transmission source address is not registered in the address book 13, the address book management section 12 registers the transmission source address in the address book 13 (step ST13).

Since the address book management section 12 of IwaZaki only registers the transmission source address in the address book 13 when the transmission source address is not registered in the address book 13, IwaZaki is not “executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded, by sending a test mail to the forward destination address and receiving a response to the test mail,” as recited in claim 1.

The address book management section 12 of IwaZaki, moreover, analyses the header of the received electronic-mail data and extracts the electronic-mail address of the transmission *source*, instead of “executing a confirmation of a validity of the forward destination address,” as recited in claim 1. In particular, as described at column 5, lines 62-67:

In transmission source address registration processing, first, the address book management section 12 analyses the header of the received electronic-mail data and extracts the electronic-mail address of the transmission source (to be referred to as a transmission source address hereinafter) (step ST11).

Since the address book management section 12 of IwaZaki analyses the header of the received electronic-mail data and extracts the electronic-mail address of the transmission source, IwaZaki is not “executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded, by sending a test mail to the forward destination address and receiving a response to the test mail,” as recited in claim 1.

In IwaZaki, moreover, the electronic-mail address of the transmission *source* can always be extracted from any electronic mail. In particular, as described at column 6, lines 1-7:

FIG. 4 is a view showing an example of the header. A character string “aaa@zzzz.co.jp” next to “From” represents the electronic-mail address of the transmission source. The header format shown in FIG. 4 is defined as the

standard of Internet mail. Hence, the electronic-mail address of the transmission source can always be extracted from any electronic mail.

Since, in IwaZaki, the electronic-mail address of the transmission source can always be extracted from any electronic mail, IwaZaki is not “executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded, by sending a test mail to the forward destination address and receiving a response to the test mail,” as recited in claim 1.

The address book management section 12 of IwaZaki, moreover, compares the transmission *source* address extracted in step ST11 with all electronic-mail addresses stored in the address book 13 to check whether the transmission source address is registered in the address book 13, instead of “executing a confirmation of a validity of the forward destination address,” as recited in claim 1. In particular, as described at column 6, lines 62-67:

Subsequently, the address book management section 12 compares the transmission source address extracted in step ST11 with all electronic-mail addresses stored in the address book 13 to check whether the transmission source address is registered in the address book 13 (step ST12).

Since the address book management section 12 of IwaZaki compares the transmission source address extracted in step ST11 with all electronic-mail addresses stored in the address book 13 to check whether the transmission source address is registered in the address book 13, IwaZaki is not “executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded, by sending a test mail to the forward destination address and receiving a response to the test mail,” as recited in claim 1.

The address book management section 12 of IwaZaki, finally, checks whether *data* representing the B mode is added to the received electronic-mail data, instead of “executing a confirmation of a validity of the forward destination address,” as recited in claim 1. In particular, as described at column 6, lines 17-20:

Next, the address book management section 12 checks whether data representing the B mode is added to the received electronic-mail data (step ST14).

Since the address book management section 12 of IwaZaki checks whether data representing the B mode is added to the received electronic-mail data, IwaZaki is not “executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the

receipt address is forwarded, by sending a test mail to the forward destination address and receiving a response to the test mail," as recited in claim 1. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 3-12 and 21 depend from claim 1 and add further distinguishing elements. Claims 3-12 and 21 are thus also submitted to be allowable. Withdrawal of the rejection of claims 3-12 and 21 is also earnestly solicited.

Claims 14, 16-20, and 22:

The second clause of claim 14 recites:

Accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address.

IwaZaki neither teaches, discloses, nor suggests "accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address," as discussed above with respect to the rejection of claim 1.

The third clause of claim 14 recites:

Issuing to a mail server, a command of confirming a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded.

IwaZaki neither teaches, discloses, nor suggests "issuing to a mail server, a command of confirming a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded," as discussed above with respect to the rejection of claim 1. Claim 14 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 14 is earnestly solicited.

Claims 16-20 and 22 depend from claim 14 and add further distinguishing elements. Claims 16-20 and 22 are thus also submitted to be allowable. Withdrawal of the rejection of claims 16-20 and 22 is earnestly solicited.

Claims 27, 29-38, and 47:

The second clause of claim 27 recites:

Accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address.

IwaZaki neither teaches, discloses, nor suggests "accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address," as discussed above with respect to the rejection of claim 1.

The third clause of claim 27 recites:

Executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded, by sending a test mail to the forward destination address and receiving a response to the test mail.

IwaZaki neither teaches, discloses, nor suggests "executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded, by sending a test mail to the forward destination address and receiving a response to the test mail," as discussed above with respect to the rejection of claim 1. Claim 27 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 27 is earnestly solicited.

Claims 29-38 and 47 depend from claim 27 and add further distinguishing elements. Claims 29-38 and 47 are thus also submitted to be allowable. Withdrawal of the rejection of claims 29-38 and 47 is earnestly solicited.

Claims 40, 42-46 and 48:

The second clause of claim 40 recites:

Accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address.

IwaZaki neither teaches, discloses, nor suggests "accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address," as discussed above with respect to the rejection of claim 1.

The third clause of claim 40 recites:

Issuing to a mail server, a command of confirming a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded.



IwaZaki neither teaches, discloses, nor suggests "issuing to a mail server, a command of confirming a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded," as discussed above with respect to the rejection of claim 1. Claim 40 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 40 is earnestly solicited.

Claims 42-46 and 48 depend from claim 40 and add further distinguishing elements. Claims 42-46 and 48 are thus also submitted to be allowable. Withdrawal of the rejection of claims 42-46 and 48 is earnestly solicited.

Claims 53, 55-64, and 73:

The second clause of claim 53 recites:

Accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail.

IwaZaki neither teaches, discloses, nor suggests "accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail," as discussed above with respect to the rejection of claim 1.

The third clause of claim 53 recites:

Executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded, by sending a test mail to the forward destination address.

IwaZaki neither teaches, discloses, nor suggests "executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded, by sending a test mail to the forward destination address," as discussed above with respect to the rejection of claim 1. Claim 53 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 53 is earnestly solicited.

Claims 55-64 and 73 depend from claim 53 and add further distinguishing elements. Claims 55-64 and 73 are thus also submitted to be allowable. Withdrawal of the rejection of claims 55-64 and 73 is earnestly solicited.

Claims 66, 68-72, and 74:

The second clause of claim 66 recites:

Accepting a setting request of a forward destination address corresponding to a

receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address.

IwaZaki neither teaches, discloses, nor suggests "accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address," as discussed above with respect to the rejection of claim 1.

The third clause of claim 66 recites:

Issuing to a mail server, a command of confirming a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded.

IwaZaki neither teaches, discloses, nor suggests "issuing to a mail server, a command of confirming a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded," as discussed above with respect to the rejection of claim 1. Claim 66 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 66 is earnestly solicited.

Claims 68-72 and 74 depend from claim 66 and add further distinguishing elements. Claims 68-72 and 74 are thus also submitted to be allowable. Withdrawal of the rejection of claims 68-72 and 74 is earnestly solicited.

#### **Conclusion:**

Accordingly, in view of the reasons given above, it is submitted that all of claims 1, 3-12, 14, 16-22, 27, 29-38, 40, 42-48, 53, 55-64, 66, and 68-74 are allowable over the cited references. Allowance of all claims 1, 3-12, 14, 16-22, 27, 29-38, 40, 42-48, 53, 55-64, 66, and 68-74 and of this entire application is therefore respectfully requested.

If there are any formal matters remaining after this response, the Examiner is invited to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge them to our Deposit Account No. 19-3935.

Respectfully submitted,

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Attachments: Replacement sheet (1)  
Annotated sheet (1)